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09/295,230	04/19/1999	CHRISTOPHER EWING	3175.01A	6950

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PETER K. TRYZNA, ESQ.  
P.O. BOX 7131  
CHICAGO, IL 60680-7131

EXAMINER
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DIXON, THOMAS A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/295,230

Applicant(s)

EWING, CHRISTOPHER

Examiner

Thomas A. Dixon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-128 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-22, 28-54, 60-86, 92-118 and 124-128 is/are rejected.
- 7) ☒ Claim(s) 10, 23-27, 55-59, 87-91 and 119-123 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Examiner appreciates Applicant's invitation to make an examiner's amendment, but the extent of changes required by numerous typographical errors introduced by applicant's 5/20/03 amendment which included the addition of claims 34-128 and subsequent amendments make the request burden on the examiner. New objections to newly discovered errors are below.
2. A careful review of the prosecution and a careful reading of the claims in light of the Bezos et al ('089) reference necessitates the removal of the notice of allowable subject matter and the introduction of the rejections below.
3. Applicant's arguments of 5/20/03 regarding the disclosure of "a blind gift" have been reconsidered, and are not convincing
4. In response to applicant's argument that the references fail to show certain features of applicant's invention, Applicant is entitled to be his own lexicographer, but the term "blind gift" is introduced in the specification on page 5 in quotation marks in regard to a program for collecting information from members regarding preferences, but does not provide specific definition as to what "a blind gift" actually is, therefore, a "blind gift" will be interpreted as "a gift" which is seen to be disclosed by Bezos.
5. In response to applicant's argument that the references fail to show certain features of applicant's invention, Examiner disagrees that Bezos does not disclose receiving a request, processing said request and enabling the gift to be sent. Beyond "enabling the gift to be sent" Bezos discloses sending the gift based on the delivery information that has been gathered by database searches and provides an order tracking feature.
6. Applicant's arguments regarding the teachings absent in Bezos and the solving of applicant's problem are not convincing. Bezos discloses a system as described in Applicant's specification on page 3, lines 11-15. Arguably, Bezos may not disclose the anonymity of the sender, as seen in the gathering of payment information, but does disclose prior art systems that accept money orders, which provides for anonymity of payment information. The Van Name description of the Bezos "gift click" invention discloses sending an email and allows for a personal not in the email, but it can also be argued that it would be obvious that the email would only contain the giver's email

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address, the personal note being an opportunity for the giver to selectively identify him/her self, as the text field can contain any message or no message. Further claims 1 and 19 do not specify that the anonymity of both parties is maintained, it simply requires that one party's anonymity is maintained. The Bezos system clearly discloses the anonymity of the recipient (only an email address or phone number is required for the sending of the gift).

### ***Claim Objections***

7. Claims 65-128 are objected to because of the following informalities:

The claims are to not revealing the "non-pseudonymous of," the examiner assumes applicant means the "non-pseudonymous name of".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

8. Claims 5-8, 37-40, 69-72, 101-104 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "if made" makes the claim indefinite, it is unclear if the step of recording will be performed, it appears that in the case that the second user does not make a choice no recording will be performed, thus removing any weight that might be given to the option to choose.

### ***Double Patenting***

9. Claims 22, 54, 86, 118 are objected to under 37 CFR 1.75 as being substantial duplicates of claims 21, 53, 85, 117 respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

10. Claims 1-4, 9, 11-14, 16, 19-22, 28-29, 30-33 are rejected under 35

U.S.C. 102(e) as being anticipated by Bezos et al (US 2002/1078089).

As per Claim 1.

Bezos et al ('089) discloses:

receiving a request over the internet from a first party for a gift to be sent to a second party, see figure 4 and paragraph (0015), lines 5-8;

obtaining over the Internet from said first party a pseudonym of said second party, see figure 5 (501a, 502a) and paragraph (0015) lines 8-14;

securing over the Internet a non-pseudonymous name and address associated with the second party's pseudonym, see figure 8 (801, 804, 805); and

producing computer output enabling said gift to be sent to said second party while said non-pseudonymous name is not revealed to said first party, see figure 8 (808).

As per Claim 2.

Bezos et al ('089) further discloses the step of issuing an order that said gift be sent to said second party's non-pseudonymous name and address, see figure 8 (809).

As per Claim 3.

Bezos et al ('089) further discloses securing said second party's non-pseudonymous name and address by looking up in a database, see figure 8 (802, 803) and figure 3 (305).

As per Claim 4.

Bezos et al ('089) further discloses contacting said second party and requesting revelation of said second party's non-pseudonymous name and address, see figure 5 (501b, 502b) and figure 3 (305).

As per Claim 9.

Bezos et al ('089) further discloses informing the first party that the second party has not chosen to accept the blind gift, see figure 9 (905).

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As per Claim 11, 28.

Bezos et al ('089) further discloses giving the first party an opportunity to reveal true identity information about said first party's self, see paragraph (0021) lines 21-23

As per Claim 12, 29.

Bezos et al ('089) further discloses giving the second party an opportunity to reveal true identity information about said second party's self, see figure 6 (603, 605).

As per Claim 13, 20.

Bezos et al ('089) further discloses electronically charging a fee, see paragraph (0021) line 21-22.

As per Claim 14.

Bezos et al ('089) further discloses electronically charging a fee to a charge card, see paragraph (0021) line 21-22.

As per Claim 16.

Bezos et al ('089) further discloses electronically charging a fee, see paragraph (0021) line 21-22.

As per Claim 19.

Bezos et al ('089) discloses:

a web site, operably connected to said computers, enabling said first party to identify send said gift to said second party by a pseudonym of said second party without said web site revealing a non-pseudonymous name to said first party, see page 2, paragraph (0016), lines 1-14.

As per Claim 21,22, 32.

Bezos et al ('089) further discloses gift is sent only responsive to an acceptance communication from the second party, see figures 5 and 6, if the telephone number is used, and a message is left, see figures 5 and 6, if the recipient doesn't return the call to provide the delivery information, the recipient has effectively refused receipt of the gift.

As per Claim 30.

Bezos et al ('089) further discloses gift is sent responsive to a message from the second party, see figure 6 (603).

As per Claim 31.

Bezos et al ('089) further discloses gift is sent responsive to an acceptance communication from the second party, see figure 6 (606).

As per Claim 33-54, 60-64.

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Bezos et al ('089) further discloses the step of processing said request to send a gift is carried out without revealing the non-pseudonymous name of said first party to said second party, and without revealing a non-pseudonymous name of said second party to said first party, see paragraph (0022) specifically lines 9-18 (the second party is given the tracking number of the gift order, not the first party's non-pseudonymous name) and paragraphs (0015) and (0017) (the first party enters only the email address or phone number of the second party and databases or contact by the service gather the information from the second party).

As per Claim 65-86, 90-96.

Bezos et al ('089) further discloses the step of processing said request to send a gift is carried out without revealing the non-pseudonymous name of said first party to said second party, see paragraph (0022) specifically lines 9-18 (the second party is given the tracking number of the gift order, not the first party's non-pseudonymous name).

As per Claim 97-118, 124-128.

Bezos et al ('089) further discloses the step of processing said request to send a gift is carried out without revealing the non-pseudonymous name of said second party to said first party, see paragraphs (0025) and (0017) (the first party enters only the email address or phone number of the second party and databases or contact by the service gather the information from the second party).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 15 is rejected under 35 U.S.C. 103(a) as obvious over Bezos (089) in view of Walker (6,330,544).

As per Claim 15.

Bezos et al ('089) further discloses electronically charging a fee to a charge card, see paragraph (0021) line 21-22.

Bezos et al ('089) does not disclose the step of confirming receipt of said order that said blind gift be sent, before electronically charging said fee to said first party.

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Walker (6,330,544) teaches charging after confirmation of receipt of a gift, see column 3, lines 31-35 for the benefit of greater flexibility in gift giving

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Bezos ('089) to confirm receipt of said order that said gift be sent, before electronically charging said fee for the benefit of greater flexibility in gift giving.

12. Claims 17, 18 are rejected under 35 U.S.C. 103(a) as obvious over Bezos (089) in view of Oneda (5,965,860).

As per Claim 17.

Bezos et al ('089) further discloses electronically charging a fee related to the value of the gift, see paragraph (0021) lines 21-22.

Bezos et al ('089) does not disclose the step of charging another fee.

Oneda ('860) teaches a membership management system that charges a membership fee, see column 6, lines 3-10 for the benefit of recovering operating costs.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Bezos ('089) to register members and charge a membership fee to recover operating costs.

As per Claim 18.

Bezos et al ('089) further discloses electronically charging a fee related to the value of the gift, see paragraph (0021) lines 21-22.

Bezos et al ('089) does not disclose the step of charging a fee to the second party.

Oneda ('860) teaches a membership management system that charges a membership fee, see column 6, lines 3-10 for the benefit of recovering operating costs.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Bezos ('089) to register members and charge a membership fee to recover operating costs.

***Not disclosed by Prior Art***

13. Claims 10, 23-27, 42, 55-58, 74, 87-90, 106, 119-122 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As per Claim 10.



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Bezos et al ('089) further discloses contacting a third party for sending of a gift, see paragraph (0003) (the postal service), but does not disclose electronically contacting a third party to send the gift.

As per Claim 23.

Bezos et al ('089) does not disclose the website enables said second party to refuse a gift from said first party if said first party is not identified by a true name.

As per Claim 24.

Bezos et al ('089) does not disclose the website enables said second party to refuse a blind gift from said first party if said first party is identified by a particular pseudonym or true name.

As per Claim 25.

Bezos et al ('089) does not disclose the website enables said second party to refuse a blind gift from said first party if said blind gift is of a particular type.

As per Claim 26.

Bezos et al ('089) does not disclose the website enables said second party to respond to said first party after delivery of a blind gift sent to said second party by said first party.

As per Claim 27.

Bezos et al ('089) does not disclose the website enables said second party to respond to said first party after refusal of an attempted blind gift to said second party by said first party.

***Prior Art Made of Record***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The Software View, Wild World of E-Commerce, Aimee Picchi and Van Name each disclose the Amazon.com Gift-Click system that allows a user to send a gift based only on the recipient's email address or phone number and are more fully disclosed by Bezos et al ('089).

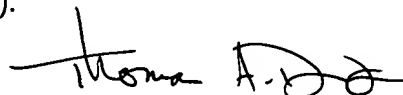
Kelly et al (6,306,035) discloses membership registration with preferences, but does not disclose preferences regarding disclosure of identity or receipt/refusal of gifts.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (571) 272-6803. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas A. Dixon  
Primary Examiner  
Art Unit 3629

February 05